

UNITED STATES PATENT AND TRADEMARK OFFICE

<b>Application No.:</b>	10/687,502	<b>Confirmation:</b>	9047
<b>Filing Date:</b>	10-15-2003	<b>Docket Number:</b>	END5008USCIP1
<b>Application Type:</b>	Utility	<b>Class / Subclass:</b>	604/167.060
<b>Examiner:</b>	Anderson, Michael J	<b>Inventor:</b>	Cropper S. Michael
<b>Group Art Unit:</b>	3767		
<b>Title:</b>	CONICAL TROCAR SEAL		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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Applicants request review of the last rejection in the above-identified application. This request is being filed with a notice of appeal. The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

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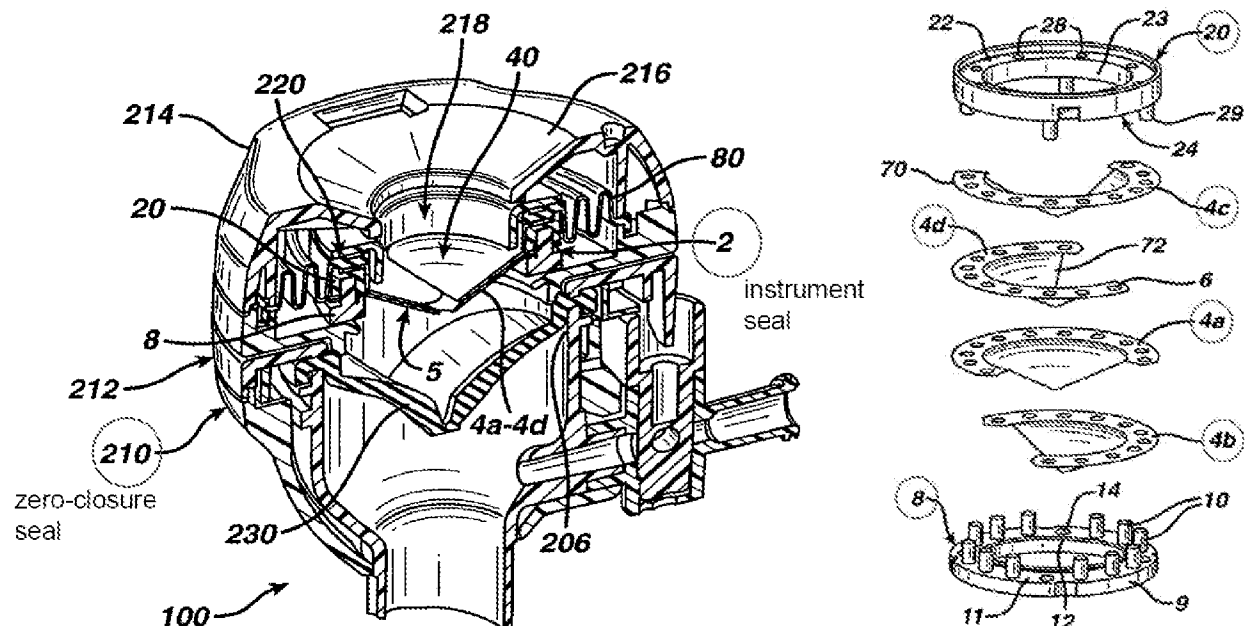
## ARGUMENTS IN SUPPORT FOR PRE-APPEAL BRIEF REVIEW

This application is currently under final rejection. Applicants believe the rejections are improper and have requested this pre-appeal brief review of the last rejection to avoid the time and expense associated with a full appeal. It is noteworthy that issues presented here are similar to those presented in a request for pre-appeal review filed in application no. 10/815356, which resulted in the rejection being withdrawn and prosecution reopened.

### I. Introduction

Trocars are used to prevent the escape of fluid or gas during endoscopic surgical procedures. Trocars typically have two distinct types of seals: (i) a zero-closure seal intended seal the trocar when there is not an instrument passing therethrough, and (ii) an instrument seal intended to seal the trocar as instruments are passed therethrough. Central to this pre-appeal is the difference between these two distinct types of trocar seals.

The present claims are directed a novel instrument seal. One embodiment of the claimed invention is depicted in Figs. 7 and 2, portions of which are reproduced below with notations:



As shown in this embodiment, the instrument seal (2) is proximal of the zero-closure seal (210). The instrument seal (2) shown in the exploded view comprises a first substantially rigid ring (8) and a second substantially rigid ring (20). A plurality of separate semicircular seal segments (4a-

4d) are compressed between the rings (8, 20) and arranged in a conical shape. Each seal segment (4a-4d) has a circumference greater than 180 degrees.

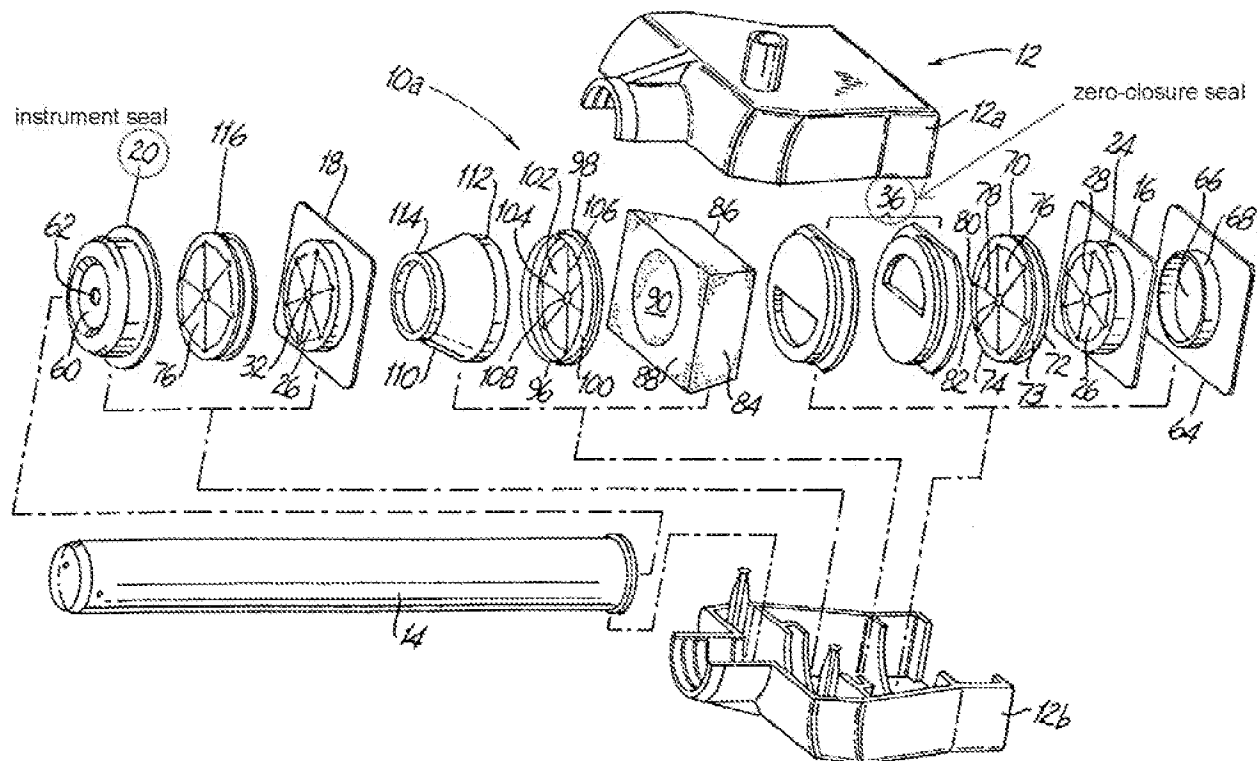
## **II. Claims on Pre-Appeal Review**

Claims 25-36 and 38-40 are pending in this application; however, for the purposes of this pre-appeal review the Applicants request the panel focus only independent claims 25, 30 and 34.

### III. Argument

The final office action dated 09/16/2010 (“FOA”) rejected claims 25-36 and 38-40 under 35 U.S.C. 102(b) as being anticipated by Green (US 6,569,120). Applicants traverse this rejection and request reconsideration because the cited portions of the reference do not teach or suggest the combination as currently claimed.

Like most trocars, Green has two seals: an instrument seal and a zero-closure. Fig. 5 of Green is reproduced below with annotations:



The proximal sealing gasket assembly (36) is intended to seal the trocar when an instrument is not positioned in the path (Green at 5:49-62). The proximal seal (36) would be referred to in the

art as a “zero-closure seal”. In contrast, the distal bellows seal (20) is intended to seal against surgical instruments when they are positioned in the trocar (Id. at 6:11-16). The distal seal (20) would be referred to in the art as an “instrument seal”. Accordingly, Green has a proximal zero-closure seal (36) and a distal instrument seal (20).

The rejection is premised on comparing Green’s proximal zero-closure seal (36) to the instrument seal as currently recited in the claims. (FOA at 3). Such a comparison is improper for at least two reasons, either one of which by itself would justify withdrawing the rejection.

#### First Error

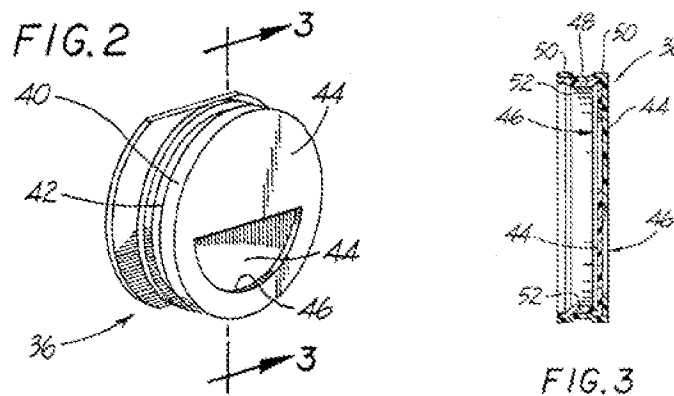
Independent claims 25, 30, and 34 each recite a seal with semicircular components arranged in “a conical shape”. The particular claim limitations are as follows:

- Claim 25: a seal assembly having a plurality of separate semicircular seal segments arranged in a conical shape, each seal segment having a circumference greater than 180 degrees and being adapted to seal against objects positioned through the seal
- Claim 30: a plurality of semicircular elastomeric members compressed therebetween and forming a conical shape, the elastomeric members circumscribing an aperture in an interwoven pattern and cooperate to sufficiently seal against objects positioned within the aperture to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures
- Claim 34: a plurality of semicircular elastomeric members compressed therebetween and forming a conical shape, the elastomeric members circumscribing an aperture in an interwoven pattern and cooperate to sufficiently seal against objects positioned within the aperture to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures

The rejection is premised on an inaccurate reading of Green. Specifically, the rejection alleges that Green discloses “a seal assembly having a plurality of separate semicircular seal segments (36) arranged in a conical shape (figures 5, 10-14; column 10, lines 11-17).”<sup>1</sup> This is wrong. The cited passage of Green describes as “conical” the seal 148 (comparable to instrument seal 20 in Fig. 5). In contrast, Green’s proximal zero-closure seal (36) is arranged in a planar configuration, as is apparent from Figs. 2-3:

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<sup>1</sup> This passage is taken from the rejection to claim 25 (FOA at 3), but similar erroneous statements were made in the rejections to claim 30 (FOA at 4) and claim 34 (FOA at 5).



Accordingly, the cited portions of Green do not teach or suggest a seal with semicircular components arranged in “a conical shape.” Since the independent claims all recite a “conical shape”, the comparison with Green’s planar seal (36) is improper.

#### Second Error

Independent claims 25, 30, and 34 each recite a seal with semicircular components arranged to create an instrument seal. The particular claim limitations are as follows:

- Claim 25: a seal assembly having a plurality of separate semicircular seal segments arranged in a conical shape, each seal segment having a circumference greater than 180 degrees and being adapted to seal against objects positioned through the seal
- Claim 30: a plurality of semicircular elastomeric members compressed therebetween and forming a conical shape, the elastomeric members circumscribing an aperture in an interwoven pattern and cooperate to sufficiently seal against objects positioned within the aperture to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures
- Claim 34: a plurality of semicircular elastomeric members compressed therebetween and forming a conical shape, the elastomeric members circumscribing an aperture in an interwoven pattern and cooperate to sufficiently seal against objects positioned within the aperture to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures

In contrast, Green’s proximal sealing gasket assembly (36) is intended to seal the trocar when an instrument is not positioned in the path (Green at 5:49-62). The proximal seal (36) would be referred to in the art as a “zero-closure seal”.

The Office Action has not accurately cited to any portion of Green in support on the proposition that Green’s proximal zero-closure seal (36) can function as an instrument seal as

recited in the claims. Indeed, the cited portions of Green (2:63-3:5, 4:50-59, and 10:11-17)<sup>2</sup> are general references to instrument seals. None of the cited portion of Green describe the zero-closure seal (36) as being arranged to create an instrument seal. Instead, Green uses a separate distal instrument seal (20) to seal against instruments. As such, independent claims 25, 30, and 34 are novel over Green.

#### **IV. Conclusion**

Based on the foregoing, the rejections to 25, 30 and 34 are in error for two separate reasons. Applicants request the panel to find the application is allowed and prosecution remain closed. While Applicants have traversed the rejections on certain grounds, the Office should appreciate the claims may be patentable on other grounds not specifically addressed in this paper. Nothing herein shall diminish or preclude other reasons the claims are patentable, and Applicants reserve all rights and arguments under the law.

Respectfully submitted,

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<sup>2</sup> Portions of Green cited in rejection to claim 25 (FOA at 3). Similar citations were presented in the rejection of claim 30 (FOA at 4) and claim 34 (FOA at 5).